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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,480	01/05/2001	Michael L. Scherbarth	P1018	5092

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EXAMINER

ZARNEKE, DAVID A

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/755,480

Applicant(s)

SCHERBARTH ET AL.

Examiner

David A. Zarneke

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a device, classified in class 257, subclass 666+.
- II. Claims 17-21, drawn to a method, classified in class 438, subclass 106+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process. For example, instead of a perforated tab, a cutout area could be used.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Donald Boys on April 2, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Hirschi, Swiss Patent 672624.

Applicant's admitted prior art teaches a lead frame apparatus comprising:

- a flat thin conductive material for forming a lead frame;
- a strip of adhesive material attached to one side of the lead frame and having the same dimensions as the lead frame; and
- a plurality of die-attach pads arranged on the side opposite of the adhesive material for receiving IC packages for encapsulation.

Applicant's admitted prior art fails to teach at least one geometric area of alteration located at either frame end to enable a user easy access to the adhesive material for the purpose of removing it from the lead frame.

Hirschi teaches a coffee cream container comprising a tab (5) extending from the container having a perforated severing line (7), wherein a cover portion (4) is removed from the container portion (2) by breaking the tab along the perforated severing line and peeling off the cover.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the perforated severing line of Hirschi in Applicant's admitted prior art because cover removal using this method makes gaining entry into the container quicker and easier.

Regarding claim 2, Applicant's admitted prior art teaches the use of a thermal resist tape.

With respect to claim 3, Applicant's admitted prior art teaches the thermal resist tape as having the same dimensions as the lead frame.

As to claim 4, Hirschi teaches a perforated tab portion (5).

Regarding claim 5, the shape of the geometric area of alteration is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

With respect to claim 6, the area the geometric area of alteration covers is an obvious matter of design choice. Design choices and changes of size are generally recognized as being within the level of ordinary skill in the art (MPEP 2144.04(d)).

As to claim 7, when transplanting the idea of Hirschi to Applicant's admitted prior art, it would have been obvious to one ordinary skill in the art at the time of the invention

to optimize the perforated line formation in the lead frame as being formed using an etching technique (MPEP 2144.05(b)).

Regarding claims 8 and 9, the use of conventional materials to perform there known functions in a conventional process is obvious. In re Raner 134 USPQ 343 (CCPA 1962). The area of alteration being an area having an absence of material is commonly known. Individual coffee cream containers, yogurt containers or butter containers found in restaurants and on airplanes are known to have an area not having any material to allow easy access to the adhesively applied cover.

As to claims 10-14, it would have been obvious to one ordinary skill in the art at the time of the invention to optimize the shape of the altered area and the number of altered areas (MPEP 2144.05(b)).

Regarding 15, Applicant's admitted prior art teaches the use of heat to aid in the removal of the adhesive material.

With respect to claim 16, the use of conventional materials to perform there known functions in a conventional process is obvious. In re Raner 134 USPQ 343 (CCPA 1962). A hot plate is a conventional, commonly used heat source that is notoriously well-known in the art.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Redmond, US Patent 6,085,942, and Lane, Sr., US Patent 4,875,620 both teach the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Zarneke whose telephone number is (703)-305-3926. The examiner can normally be reached on M-Th (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703)-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-7722 for regular communications and (703)-308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.



David A. Zarneke  
June 14, 2002